

REMARKS/ARGUMENTS

Claims 1, 2, 5-7, 9, 11, and 27 are pending in this application. Claims 3, 4, 8, 10, and 12-26 have been previously canceled.

Reconsideration of this Application is respectfully requested. This amendment addresses items brought up by the examiner in the final office action and advisory action. In view of the following remarks and evidence, favorable consideration and allowance of the application is respectfully requested.

35 U.S.C. §103 Rejections

Claims 1, 2, 5-7, 9, 11, and 27 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Eury (USPN 5, 443,458) in view of WO 01/07066 (hereinafter “WO ‘066”).

To reject a claim under 35 USC §103(a), the Examiner bears the initial burden of showing an invention to be *prima facie* obvious over the prior art. See *In re Bell*, 26 U.S.P.Q.2d 1529 (Fed. Cir. 1992). If the Examiner cannot establish a *prima facie* case of unpatentability, then without more the applicant is entitled to grant of the patent. See *In re Oetiker*, 24 U.S.P.Q.2d 1443 (Fed Cir. 1992). The Examiner must meet a three-part test to render a claimed invention *prima facie* obvious.

To begin with, the prior art references cited by the Examiner must provide “motivation, suggestion, or teaching of the desirability of making the specific combination that was made by the application.” See *In re Kotzab*, 55 U.S.P.Q.2d 1316 (Fed. Cir. 2000). Where one reference is relied upon by the Examiner, there must be a suggestion or motivation to modify the teachings of that reference. See *id.* Where an obviousness determination relies on the combination of two or more references, there must be some suggestion or motivation to combine the references. See *WMS Gaming Inc. v. International Game Technology*, 51 U.S.P.Q.2d 1386 (Fed. Cir. 1999). The suggestion may be found in implicit or explicit teachings within the references themselves, from the ordinary knowledge of one skilled in the art, or from the nature of the problems to be solved. See *id.* Further, if the proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified, then the teachings of the

references are not sufficient to render the claims *prima facie* obvious. *In re Ratti*, 123 U.S.P.Q. 349 (CCPA 1959).

Second, the prior art references cited by the PTO must suggest to one of ordinary skill in the art that the invention would have a reasonable expectation of success. See *In re Dow Chemical*, 5 U.S.P.Q.2d 1529 (Fed. Cir. 1988). The expectation of success, like the motivation to combine two prior art references, must come from the prior art, not the applicant's disclosure. See *id.*

Finally, the Examiner must demonstrate that the prior art references, either alone or in combination, teach or suggest each and every limitation of the rejected claims, See *In re Gartside*, 53 U.S.P.Q.2d 1769 (Fed. Cir. 2000).

If any one of these three factors is not met, the PTO has failed to establish a *prima facie* case of obviousness and the applicant is entitled to grant of a patent without making any affirmative showing of non-obviousness.

Eury discloses a stent comprised of a biodegradable multilayered laminated construction wherein one layer represents the stent body and additional layers release drugs. WO '066 discloses PPAR δ antagonists for the reduction or prevention of the development of foam cells from macrophages. The inventors of the WO '066 application suggest that drugs with this mechanism of action may also be used for the prevention of restenosis. WO '066 also discloses that a PPAR γ agonist, rosiglitazone, inhibits macrophage foam cell formation.

WO '066 is not prior art to the present patent application. International Patent Application No. WO 01/07066 was filed 19 July 2000. Thus, WO '066 can only be a prior art reference under 35 U.S.C. § 102(a) and (b) as of its publication date, 1 February 2001. The Declaration of Peiwen Cheng under 37 C.F.R. §1.131 ("the Cheng Declaration") and its associated evidence submitted herewith, establish that the claimed invention was reduced to practice before February 1, 2001. Therefore, the WO '066, is not prior art to the Applicant's application.

Regarding the first factor of obviousness, there is no motivation found in the cited references that would give one of ordinary skill in the art the motivation to combine them.

Examiner has not provided “motivation, suggestion, or teaching of the desirability of making the specific combination that was made by the application.” Further, combination of the Eury stents with WO ‘066 to make the coated stents of the invention would change the principle of operation of the laminated stents of Eury which rely on their multilayered laminated construction to achieve the desired structural and functional properties. Eury, column 2, lines 9-20. Therefore, a *prima facie* case of obviousness cannot be made with these references.

Regarding the second factor of obviousness, one of ordinary skill in the art would have no reasonable expectation of success in the combination of these references to make the claimed coated stent. Eury teaches away from the combination and gives no reasonable success in the combination when it discloses that a multilayered laminated construction is key to obtaining the desired structural and functional properties. Eury, column 2, lines 9-20.

Therefore, since the Examiner has not established a *prima facie* case of obviousness of claims 1, 2, 5-7, 9, 11 and 27 over Eury in view of WO 01/07066, it is respectfully requested that the Examiner withdraw this ground of rejection.

Conclusion

For the foregoing reasons, Applicant believes all the pending claims are in condition for allowance and should be passed to issue. The Commissioner is hereby authorized to charge any additional fees which may be required under 37 C.F.R. 1.17, or credit any overpayment, to Deposit Account No. 01-2525. If the Examiner feels that a telephone conference would in any way expedite the prosecution of the application, please do not hesitate to call the undersigned at telephone (707) 543-5021.

Respectfully submitted,

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